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Express Label No. EL953478123US  
Date of Deposit: July 2, 2002

ATTORNEY'S DOCKET NO. C1039/7005 (HCL)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Krieg et al.  
Serial No.: 08/960,774  
Filed: October 30, 1997  
For: IMMUNOSTIMULATORY NUCLEIC ACID MOLECULES  
Examiner: J. Martinell  
Art Unit: 1633

Office of Petitions

Assistant Commissioner for Patents  
Washington, D.C. 20231

**CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)**

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Office of Petitions, the Assistant Commissioner for Patents, Washington, D.C. 20231, on the 7<sup>th</sup> day of March, 2000.

  
Helen C. Lockhart

Sir:

**PETITION TO CORRECT INVENTORSHIP UNDER 37 CFR §1.48**

Applicants respectfully petition the Commissioner of the United States Patent and Trademark Office, pursuant to 37 CFR §1.48, to correct inventorship on the present application.

Due to claim restriction on the present application and the filing of a divisional application, Dr. Joel Kline, an originally named inventor, is no longer an inventor of the present invention as claimed. Specific guidelines for correction of inventorship of a pending patent application have been promulgated at 37 CFR §1.48. This section states in part "(b) if the correct inventors are named in a nonprovisional application, ... and the prosecution of the application results in the amendment or cancellation of claims so that fewer than all the currently named inventors are the actual inventors of the invention being claimed in the application, an amendment must be filed deleting the name or names of the person or person who are not inventors of the invention being claimed. ... Such amendment must be accompanied by:

(1) A petition including a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application; and

(2) The fee set forth in §1.17 (i).

The invention of Dr. Joel Kline is no longer being claimed in the present application. Applicants respectfully request that the Patent Office delete Dr. Joel Kline as an inventor from this patent application.

Applicants further respectfully petition the Commissioner of the United States Patent and Trademark Office, pursuant to 37 CFR §1.48, to correct a failure to name two inventors to the originally-filed patent application. Through errors Dr. Alfred D. Steinberg and Dr. Dennis Klinman were incorrectly not named as inventors of the above-identified patent application without deceptive intent on their part. Specific guidelines for correction of inventorship of a pending patent application have been promulgated at 37 CFR §1.48. This section states in part "(a) if the inventive entity is set forth in error in an executed §1.63 Oath or Declaration in an application, other than a reissue application, and such error arose without any deceptive intent on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the application may be amended to name only the actual inventor or inventors. ... Such amendment must be accompanied by:

- (1) A petition including a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (2) An oath or declaration by the actual inventor or inventors as required by §1.63 or as permitted by §§1.42, 1.43, or 1.47;
- (3) The fee set forth in §1.17 (i); and
- (4) If an assignment has been executed by any of the originally named inventors, the written consent of the Assignee.

Applicants request that the Patent Office add Dr. Alfred D. Steinberg and Dr. Dennis Klinman to this patent application.

Attached to this Petition are the following as required by 37 CFR §1.48 (a):

- A verified statement from each of Dr. Alfred D. Steinberg and Dr. Dennis Klinman stating that the error in inventorship occurred without deceptive intention on his part;
- A verified statement signed by an official of the Assignee, The University of Iowa Research Foundation, to whom the originally named inventors, Drs. Arthur Krieg and Joel Kline, assigned all of their rights;
- A check for the fee set forth in 37 CFR §1.17(i) in the amount of \$130.00.

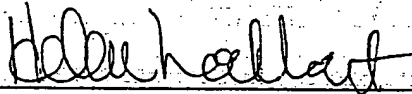
The Facts:

On December 6, 1999, an independent arbitrator rendered an opinion in an arbitration concerning an inventorship dispute of the above-identified patent application. The decision of the arbitrator, which was approved by all parties, found that inventorship had been improperly named in the above-identified patent application. It was found that Dr. Dennis Klinman and Dr. Alfred D. Steinberg are inventors of the claims as filed. In view of that opinion, Applicants have promptly initiated the steps to amend inventorship as described herein.

Applicants have also submitted herewith copies of documents relevant to the issue of inventorship. These documents include a letter dated April 11, 1995 from Dr. Arthur Krieg to Dr. Alfred D. Steinberg describing discussions related to the invention (Exhibit 1), a United States Patent Application (Serial No. 09/136,138) filed on August 18, 1998 by the National Institutes of Health during the resolution of the inventorship issues (Exhibit 2), and a copy of an Express Abandonment of Application under 37 CFR §1.138 for U.S. Serial No. 09/136,138 (Exhibit 3). Applicants respectfully request that the Examiner and Petitions Office consider each of the attached documents.

Should any questions remain regarding this petition, it is requested that the Examiner contact Applicants' representative, as signed below.

Respectfully Submitted,



Helen C. Lockhart, Reg. No. 39,248  
Wolf, Greenfield & Sacks, P.C.  
600 Atlantic Avenue  
Boston, MA 02210-2211  
Tel (617)720-3500

Attorney Docket No. C1039/7005

Date: March 7, 2000

NDD



Express Mail Label No. EL953478123US  
Date of deposit: July 2, 2002

ATTORNEY'S DOCKET NO. C1039/7005 (HCL)

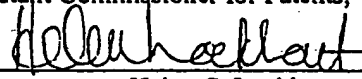
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Applicant: Krieg et al.  
Serial No.: 08/960,774  
Filed: October 30, 1997  
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Examiner: J. Martinell  
Art Unit: 1633

Office of Petitions  
Assistant Commissioner for Patents  
Washington, D.C. 20231

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Helen C. Lockhart

Sir:

Verified Statement of Dr. Alfred D. Steinberg

I, Alfred D. Steinberg, state the following:

1. There was an error in not naming myself as an inventor to the above-identified patent application and this error occurred without any deceptive intention on my part.
2. I hereby declare that all statements herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the patent issued thereon.

Date: 2-20-2000

Signature: 

Alfred D. Steinberg



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Date of Deposit: July 2, 2002

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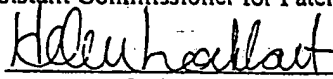
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Helen C. Lockhart

Sir:

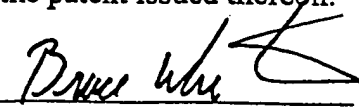
Verified Statement of The University of Iowa Research Foundation

Statement in Support of Correction of Inventorship Under 37 CFR §1.48

1. I, Bruce Wheaton, an official of The University of Iowa Research Foundation hereby verify that The University of Iowa Research Foundation agrees with the petition to amend inventorship attached hereto. Inventorship was named improperly when the above-identified patent application was filed, but this error was a mistake, and involved no deceptive intent on the part of The University of Iowa Research Foundation.

2. I hereby declare that all statements herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the patent issued thereon.

Date: 2/8/00

Signature:   
Bruce Wheaton



Expre Mail Label No. EL953478123US  
Date of Deposit: July 2, 2002

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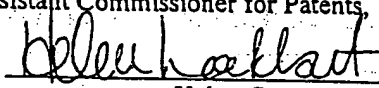
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Helen C. Lockhart

Sir:

Verified Statement of Dr. Dennis Klinman

I, Dennis Klinman, state the following:

1. There was an error in not naming myself as an inventor to the above-identified patent application and this error occurred without any deceptive intention on my part.
2. I hereby declare that all statements herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the patent issued thereon.

Date: 3/1/2000

Signature: 

Dennis Klinman





Express Label No. EL953478123US  
Date of Deposit: July 2, 2002

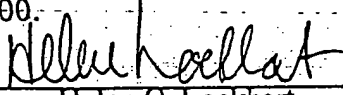
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The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to, Office of Petitions, Commissioner for Patents, Washington, D.C. 20231, on the 28th day of August, 2000.

  
Helen C. Lockhart

OFFICE OF PETITIONS  
COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

Sir:

**SUPPLEMENTAL PETITION TO CORRECT**  
**INVENTORSHIP UNDER 37 C.F.R. §1.48**

Applicants respectfully submit the Supplement Petition to the Commissioner of the United States Patent Office pursuant to 37 C.F.R. §1.48 to correct inventorship on the present application. On March 7, 2000, the following documents were submitted to the Commissioner in order to correct inventorship:

Petition to Correct Inventorship under 37 C.F.R. §1.48  
Exhibits 1, 2, and 3  
Check in the Amount of \$130.00  
Verified Statements of Drs. Steinberg and Klinman  
Verified Statement of the University of Iowa Research Foundation (Assignee)  
Declaration of Patent Application  
Return Receipt Postcard

Examiner James Martinell in communication paper no. 21 mailed on April 28, 2000 notified Applicants that the Petition to Correct Inventorship was deficient for the following reasons:

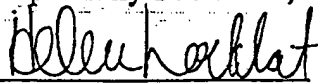
An additional Petition fee of \$130.00 was required for deletion of an inventor (Dr. Joel Kline) associated with the Petition Under 37 C.F.R. §1.48(b). Applicants enclose herewith a check \$130.00 for the additional Petition fee under 37 C.F.R. §1.48(b).

The Statement of Mr. Wheaton was deemed to be insufficient because it did not establish ownership of the application as required under 37 C.F.R. §3.73(b). Applicants submit herewith a new Statement of Mr. Wheaton which cites the reel and frame number of the Assignment document which was recorded indicating that Dr. Joel Kline and Dr. Arthur Krieg both assigned all of their rights in the invention to the University of Iowa Research Foundation. Applicants also enclose a copy of the recorded Assignment.

The Statement of Mr. Wheaton was also deemed to be insufficient because it did not establish Mr. Wheaton as having authority to act on behalf of the Assignee. The new Statement of Mr. Wheaton establishes that Mr. Wheaton has the authority to act on behalf of the Assignee. Applicants have also enclosed copies of two letters from the University of Iowa to Dr. Wheaton granting Dr. Wheaton signatory authority on behalf of the University of Iowa Research Foundation for all University of Iowa Research Foundation documents dealing with licenses, patent materials, etc.

It is believed that the supplementary evidence provided herein is sufficient to complete the Petition filed on March 7, 2000. It is respectfully requested that the Petition be granted.

Respectfully Submitted,



Helen C. Lockhart

Reg. No. 39,248

Wolf, Greenfield & Sacks, P.C.

600 Atlantic Avenue

Boston, MA 02210-2211

(617) 720-3500

Docket No. C1039/7005(HCL)

Date: August 28, 2000

X08/28/00



Express Mail Label No. EL953478123US  
Date of Deposit: July 2, 2002

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Helen C. Lockhart

Sir:

Verified Statement of the University of Iowa Research Foundation

Statement in Support of Correction of Inventorship Under 37 CFR §1.48

1. I, W. Bruce Wheaton, am an official of the University of Iowa Research Foundation and have authority to act and sign on behalf of the University of Iowa Research Foundation.

2. The University of Iowa Research Foundation is the sole and exclusive assignee of the rights of Arthur M. Krieg and Joel Kline in the above-identified patent application, and as such is the sole owner of this patent application at this time. Assignments evidencing this ownership have been recorded with the USPTO on February 23, 1998, reel and frame 9069/0320. (copy enclosed)

3. I hereby verify that the University of Iowa Research Foundation agrees with the petition to amend inventorship attached hereto. Inventorship was named improperly when the

above-identified patent application was filed, but this error was a mistake, and involved no deceptive intent on the part of the University of Iowa Research Foundation.

4. I hereby declare that all statements herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the patent issued thereon.

Date:

5/12/01

Signature:

W. Bruce Wheaton  
W. Bruce Wheaton